

REMARKS

In the Office Action¹ the Examiner rejected claims 31-53 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,963,925 to Kolling ("*Kolling*") in view of U.S. Patent No. 6,094,505 to *Lech* ("*Lech*").

By this amendment, Applicant amends claims 31, 39, 43 and 46. Support for the amendments can be found at least in the claims as originally filed and in the specification at, for example, page 18, line 20 - page 19, line 20 Claims 31-53 are pending.

Rejection Under 35 U.S.C. § 103(a)

Applicant respectfully traverses the rejection of claim 31, insofar as it applies to the claim as amended, under 35 U.S.C. §103 as being obvious from *Kolling* in view of *Lech*. A *prima facie* case of obviousness has not been established.

"The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. . . . [R]ejections on obviousness cannot be sustained with mere conclusory statements." *M.P.E.P.* § 2142, 8th Ed., Rev. 7 (July 2008)(*internal citation and inner quotation omitted*). "[T]he framework for the objective analysis for determining obviousness

¹ The Office Action may contain statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art." M.P.E.P. § 2141(II). In rejecting a claim, "Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art." M.P.E.P. § 2141(III). Here, no *prima facie* case of obviousness has been established for at least the reason that the scope and content of the prior art have not been properly determined nor have the differences between the claimed invention and the prior art been properly ascertained.

Independent claim 31 calls for a combination including, for example:

identifying a type of the scanned paper bill from the generated electronic image information by comparing optical character recognition (OCR) data generated from the electronic image to a list of types stored in a memory
[and]
extracting billing information from the electronic image information using a predefined template corresponding to the identified bill type, wherein the predefined template includes zone information for locating portions of the billing information (emphasis added).

The cited art, alone or in combination, fails to disclose or suggest at least these elements of claim 31.

On page 3 of the Office Action, the Office Action correctly concedes that "Kolling et al does not explicitly recite the manner in which the paper bills were transformed or scanned into electronic bills or documents." However, the Office Action alleges that *Lech* discloses these claimed features. More particularly, the Office Action alleges that *Lech* discloses:

identifying a type of the scanned paper bill; [and] extracting billing information from the electronic image information using a predefined

template corresponding to the identified bill type, wherein the predefined template includes zone information for locating portions of the billing information

in the abstract, in column 6, line 66 - column 7, line 19, and in column 10, lines 30-65.

This is incorrect.

Lech discloses a method and apparatus for paying bills electronically using machine readable information from an invoice (title). *Lech* states, in column 6, lines 61-65:

the user may optionally create a template[...] for each different type of invoice. This template is stored for future use when another hard copy document in the same format is received (emphasis added).

However, *Lech* also discloses in column 10, lines 35-40 that:

[t]he user can use the template to extract selected portions of information off of the hard copy document when the document is originally inputted, or alternatively, the user can use the template to identify selected portions of information for extraction off of an image copy of the document (emphasis added).

Therefore, in *Lech*, the user “use[s] the template to identify selected portions of information for extraction off of an image copy of the document.” There is no disclosure in *Lech* that the user “identif[ies] a type of the scanned paper bill,” much less that the user does so “from the generated electronic image information,” as claimed. Yet even if *Lech* were to teach these features, which Applicant submits it does not, *Lech* would still fail to disclose or suggest at least “identifying a type [...] by comparing optical character recognition (OCR) data generated from the electronic image to a list of types stored in a memory” (emphasis added), as claimed.

Lech discloses in the abstract that:

[p]ortions of the stored document information are selected in accordance with content instructions which designate portions of the stored document information required by a particular application program.

Lech further discloses in column 13, lines 32-35:

[t]he user employs content instructions to designate how pieces of information, which have been extracted off of hard copy document 100, are directed to particular departments (emphasis added).

Therefore, “content instructions” in *Lech* are used to direct information that has already been extracted from a “hard copy document,” not to “[extract] billing information from the electronic image information,” as claimed. Moreover, there is no disclosure in *Lech* that that the “content instructions” “[correspond] to [an] identified bill type,” as claimed.

The Examiner alleges that *Lech* teaches “zone information [for ‘extracting billing information from the electronic image information’]” from column 6, line 66 - column 7, line 19. This is incorrect. *Lech* actually discloses from column 6, line 66 - column 7, line 12 that:

instructions from computer 230 can direct the scanner 210 and scanner memory 220, and/or main memory 250, to scan and/or store only specific portions of hard copy document 100. [...] More specifically, in FIG. 2, the lines 10 drawn around certain portions of the document represent the areas which the user has previously identified as the portions of a document to be extracted by the scanner 210 and stored in scanner memory 220 and/or main memory (emphasis added).

Even if *Lech* were to teach “zone information,” which Applicant does not concede, the “zone information” would represent “instructions [...] to scan and/or store only specific portions of hard copy document 100,” not “for locating portions of the billing information [for ‘extracting billing information from the electronic image information’],” as claimed.

Therefore, *Lech* fails to teach, disclose or suggest at least:

identifying a type of the scanned paper bill from the generated electronic image information by comparing optical character recognition (OCR) data generated from the electronic image to a list of types stored in a memory [and]
extracting billing information from the electronic image information using a predefined template corresponding to the identified bill type, wherein the predefined template includes zone information for locating portions of the billing information

as recited in claim 31, as amended.

In view of the deficiencies of the prior art set forth above, the Office has neither properly determined the scope and content of the prior art nor ascertained the differences between the claimed invention and the prior art. Accordingly, no reason has been articulated as to why one of skill in the art would find the claimed combination obvious in view of the prior art. For at least this reason, no *prima facie* case of obviousness has been established. The rejection of independent claim 31 under 35 U.S.C. §103 as being obvious from *Kolling* in view of *Lech*, insofar as it applies to the claim as amended, is thus improper and should be withdrawn. The rejections under 35 U.S.C. §103 of independent claims 39, 43, and 46 should be withdrawn for at least the reasons given above with respect to claim 31 since claims 39, 43 and 46 recite similar elements as above.

Moreover, rejections under 35 U.S.C. §103 of claims depending from independent claims 31, 39, 43, and 46 are improper and should be withdrawn for at least reasons given above with respect to the independent claims.

CONCLUSION

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

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By: _____

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